

**REMARKS**

Reconsideration of the present application is respectfully requested.

Claims 1 and 5 have been rejected under 35 U.S.C. 112, first paragraph as not complying with the written description requirement.

Claims 1 and 5 have been amended to recite *inter alia* a molded part that has a low deformation tensile stress of approximately 300 Kpa and that is composed of a non-foamed thermoplastic olefin elastomer with a hardness of approximately Hs 50° corresponding to the low deformation tensile stress of approximately 300 Kpa, and that the extruded member and the molded part have an approximately identical hardness. Support for this approximately Hs 50° hardness and approximately 300 Kpa low deformation tensile stress may be found for example, in the paragraph beginning on page 7, line 14 of the present application.

Therefore, as claims 1 and 5 comply with the written description requirement, it is respectfully requested that the Examiner's rejection under 35 U.S.C. 112, first paragraph be withdrawn.

Claims 1 and 5 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshida in view of Brzoskowski '502 and Brzoskowski '964. This rejection is respectfully traversed.

As now recited in claims 1 and 5, the door weather strip of the present invention includes an extruded member composed of foamed thermoplastic olefin elastomer (TPO) that is prepared by chemical foaming and has an average cell diameter of 30 to 70  $\mu\text{m}$ , an expansion ratio of 150 to 250 % and a low deformation tensile stress of approximately 300 Kpa. The door weather strip of the present invention as recited in claims 1 and 5 also has a molded part composed of a non-foamed TPO with a hardness of approximately Hs 50°. This hardness corresponds to a low

deformation tensile stress of approximately 300 Kpa. In addition, the extruded member and the molded part have approximately the same hardness so that, as recited in claim 1, the door weather strip exhibits approximately uniform flexibility over its entire length.

As discussed in the Amendment filed on June 25, 2003, the weather strip of the present invention provides superior and unexpected results, as it has smooth surfaces and exhibits good sealing and attachment properties (see page 3, lines 20 – 24). In addition, the door weather strip provides approximately uniform flexibility over its entire length. The superior and unexpected results are in part due to the fact that the extruded part is made of a TPO with the specific recited characteristics (a cell diameter of 30 to 70  $\mu\text{m}$ , an expansion ratio of 150 to 250 %, and a low deformation tensile stress of approximately 300 Kpa). The superior and unexpected results are also in part due to the fact that the molded part is made of a TPO with a hardness of approximately Hs 50° and the fact that the molded piece and the extruded piece are composed of materials of similar hardness.

On the contrary, Yoshida describes an automobile weather strip formed from both an extrusion-molded part (12, 14) and a mold-formed part (16) welded to the extrusion-molded part. As noted by the Examiner, Yoshida fails to teach or suggest an extruded member made of a foamed TPO.

The Examiner, however, asserts that Brzoskowski '502 and Brzoskowski '964 both make up for the deficiencies of Yoshida. However, these two references each describe a foamed thermoplastic article made from only foamed extruded TPO (col. 1, lines 45-52), and neither teaches nor suggests a thermoplastic article with a molded corner, much less a thermoplastic article that includes an extruded member and a molded part with approximately the same

hardness and deformation tensile stress, and that exhibits an approximately uniform flexibility over an entire length thereof.

The Examiner further states that, in the absence of unexpected results, it would have been obvious to produce an extruded foamed TPO member with a tensile stress at break within the claimed range to obtain a weather seal with fine and uniform cell structure to produce smooth surfaces for improved sealing against incoming air and water, as is important to Yoshida.

However, the present invention does produce unexpected results as discussed above. Therefore, it appears that the above combination of references presented by the examiner is tantamount to a reconstruction of the claimed invention by picking components of several references from diverse arts and using the applicants' invention as a blue print to make the combination. This is supported by the fact that each of the cited references does not disclose several of the specific characteristics recited in claims 1 and 5 and instead at best discloses only one or two specific characteristics. The Examiner had to rely on multiple references to piece together a rejection of the applicants' claims 1 and 5. Applicants again remind the examiner that he cannot pick and choose among references using hindsight based on knowledge that was gleaned from the applicants' disclosure (see MPEP §2145 (X)(a)).

Further, there is no motivation to combine the references as asserted by the Examiner. Specifically, why would one skilled in the art look to the Brzowski references to cure the deficiencies in Yoshida when Yoshida describes a two-part weather strip (extrusion-formed part and mold-formed part) and the Brzowski references describe a single part extruded foamed TPO composition? The two-part weather strip of Yoshida has associated sealing and appearance issues that are unique to its two-part structure and that are not addressed by single-part composition references such as the Brzowski references.

The Examiner also asserts that the extruded member expansion ratio and uniform flexibility over the entire length of the door weather seal would be inherently present. This is true if one skilled in the art were to use applicants' disclosure as a blueprint as discussed above. In addition, based on the cited references, and specifically on the fact that neither of the Brzowski references teaches a weather strip with an extruded TPO part and a molded non-foamed TPO part, why would the uniform flexibility be inherent, if Yoshida is deficient in teaching in the many ways noted already by the Examiner, and when weather strips taught by the Brzowski references are single part compositions, and therefore the issue of non-uniform flexibility due to the use of two different types of parts is not even addressed?

If assuming *arguendo* that the Examiner wishes to maintain this rejection based on inherency, applicants direct the Examiner's attention to MPEP 2112, which states:

"In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." Ex parte Levy, 17 USPQ2d 1461, 1464 (BPAI 1990). (MPEP 2112, 8<sup>th</sup> Ed., Rev. 1, Feb. 2003)

The Examiner has not provided any technical reasoning or support for his conclusory assertions that the expansion ratio and uniform flexibility of the weather strip in Yoshida would be inherent other than his flawed obviousness analysis. Specifically, why would the above features of the present invention be inherently taught by the cited references in view of the deficient teachings of these references? Applicants request that the Examiner cite a reference that supports such conclusory assertions or withdraw his rejection.

Therefore, as the string-cited combination of references does not render the present invention obvious, the applicants respectfully request that the Examiner's rejection of claims 1 and 5 be withdrawn.

Claim 5 has also been rejected under 35 U.S.C. 103(a) as being unpatentable over Mori in view of Brzowski '502, Brzowski '964 and Kato. This rejection is respectfully traversed.

As already discussed in the earlier filed June 25, 2003 Amendment, Mori discloses a weather strip that includes an extruded portion and a molded portion for connecting ends of the extruded portion. Mori also discloses that the extruded portion includes a TPO rubber solid part and a TPO sponge part. Mori does not, however, show or suggest that the door weather strip exhibits approximately uniform flexibility. In addition, Mori does not disclose the cell diameter and the expansion ratio of the sponge part of the extruded portion recited in claim 5 of the present invention. Further, yet Mori does not disclose that the molded portion and the extruded portion have approximately the same hardness as recited in claim 5.

Brzowski '502 and Brzowski '964 both describe a foamed thermoplastic article made from only foamed extruded TPO (col. 1, lines 45-52), and neither teach nor suggest a thermoplastic article with a molded corner, much less a thermoplastic article that includes an extruded member and a molded part having approximately the same hardness as the extruded member recited in claim 5.

Kato discloses a movable window 1 that includes a transparent synthetic resin plate 11, a molding 12 arranged to peripherally encompass the plate 11 and a weather strip 4. Kato teaches that the molding 12 is made of flexible polyvinyl chloride, ethylene-propylene-diene terpolymer (EPDM) or TPO and that the rubber hardness of the molding 12 is preferably between Hs 20° and 80°. However, as shown, for example, in FIG. 1, Kato fails to show or suggest that the weather strip 4 includes an extruded member such as that recited in claim 5. This is because the weather strip 4 and the molding 12 have block-shaped configurations designed for use in an automobile sunroof, and their respective flexibilities are therefore not important. Therefore, the

hardness and flexibility of the molding and of the weather strip can be within a wide range, i.e., from Hs 20° to 80°.

Although the ranges of hardness recited in claim 5 and disclosed by Kato overlap, the inclusion of a molded part composed of a non-foamed TPO that has a hardness of approximately Hs 50° is critical to obtain the superior and unexpected results obtained by the weather strip of the present invention. When the hardness is not approximately Hs 50°, the weather strip does not provide adequate flexibility to provide adequate sealing. In addition, Kato neither shows nor suggests making the hardness of the extruded member and the molded part approximately equal to make the flexibility of the door weather strip uniform.

Mori, Brzowski '502, Brzowski '964 and Kato, considered individually or in combination, fail to show or suggest a weather strip that provides the superior results provided for in the weather strip recited in claim 5.

Further, the applicants again remind the examiner that he cannot pick and choose among references using hindsight based on knowledge that was gleaned from the applicants' disclosure (see MPEP §2145 (X)(a)). It appears that the combination of Mori, Brzowski '502, Brzowski '964 and Kato presented by the examiner is tantamount to a reconstruction of the claimed invention by picking components of several references from diverse arts and using the applicants' invention as a blue print to make the combination. This is supported by the fact that each of the cited references does not disclose several of the specific characteristics recited in claim 5 and instead recites only one or two specific characteristics. The Examiner had to rely on multiple references to piece together a rejection of the applicants' claim 5, and has merely re-inserted two different references, Brzowski '502 and Brzowski '964, in an unsuccessful

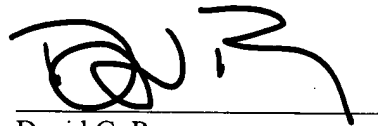
attempt to shore up the deficiencies of Mori and Kato, which were used in the Examiner's previous obviousness rejection of claim 1.

Therefore, as the string-cited combination of references does not render the present invention obvious, the applicants respectfully request that the rejection of claim 5 be withdrawn.

In view of the above amendments and remarks, the present application is now believed to be in condition for allowance. A prompt notice to that effect is respectfully requested.

A Petition for a one-month extension of time and the a check for the requisite petition fee are included herewith. Please charge any additional necessary fees to Deposit Account No. 50-1147.

Respectfully submitted,

A handwritten signature in black ink, appearing to be 'DGP' with a stylized flourish extending to the right.

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